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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,475	07/01/2003	Akio Sugimoto	KOBE.0052	1029

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EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/609,475	SUGIMOTO ET AL.	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *19-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 23-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election of Group I, claims 1-18 and 23-32 in the reply filed on 11/04/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. The 112 claim rejections have been withdrawn in view of the present amendment.
3. The amendments to the original specification are entered because they are intended to correct informality and do not affect the scope of the invention.
4. All of the 102 art rejections are now changed to 102/103 art rejections in view of the present amendment. Additionally, new ground of rejection is made in view of Nagano et al (US 5,443,900).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-14, 16, 23-29, and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagano et al (US 5,443,900). Nagano discloses an electromagnetic wave absorber comprising a substrate, a layer of pigment dispersed resin and a metal layer (column 2, lines 10-11, 35-40 and 55-56). The substrate is made from PET (column 2, lines 38-39). The layer of pigment dispersed resin is formed from polyester resin (column 2, lines 17-18). Since the substrate and the resin layer are made of chemically different material, it is not seen that the substrate and resin layer could not have foamed at the same foaming temperature. The same token is applied to the melting temperature of the substrate and the resin layer. The electromagnetic wave absorber is in the form of a coil which reads on Applicants' shape formable hard plate. Nagano does not teach or suggest the resin layer adhered to the hard plate prior to heating. However, they are product-by-process limitations not as yet shown to produce a patentably distinct article. It is the examiner's position that the laminate structure is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The laminate structure comprises of a

substrate/foamable resin layer/hard plate or non-foam/ foamable resin/ hard plate. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi,*** 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Nagano.

8. Claims 1-6, 11, 12, 14-18, 27, 29 and 30-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Holtrop et al (US 4,557,970) substantially as set forth in the 05/20/2005 Office Action.
9. Claims 1-18 and 23-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sato et al (US 4,734,323) substantially as set forth in the 05/20/2005 Office Action.

10. Claims 1-6, 11, 12, 14-18, 27, 29-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 1020846 substantially as set forth in the 05/20/2005 Office Action.

11. Claims 1, 2, 5-9, 11, 12, 15-18, 23, 24, 27 and 30-32 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wycech (US 6,372,334) substantially as set forth in the 05/20/2005 Office Action.

Response to Arguments

12. All of the 102 art rejections have been changed to 102/103 art rejections because all of the applied references do not teach or suggest the foamable resin adhered to the hard plate prior to heating. However, they are product-by-process limitations not as yet shown to produce a patentably distinct article. It is the examiner's position that the laminate structure is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. The laminate structure comprises of a foam layer/foam layer/hard plate or non-foam/ foam layer/ hard plate. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to

show unobvious differences between the claimed product and the prior art product. ***In re Marosi,*** 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied references.

13. The art rejections over Holtrop have been maintained for the following reasons. Applicants argues that since an adhesive layer is required to bond the foam layer 13 to the foam layer 14 which corresponds to Applicants' hard plate, Holtrop does not anticipate the claimed subject matter. The examiner disagrees. The arguments are not found persuasive because they are not commensurate in scope with the claims. Nothing in the claim specific about the foamable resin layer in direct contact of the hard plate. The recitation "adhered to" does not exclude an embodiment wherein there are intervening layers between the hard plate and the foamable resin layer. Holtrop does not disclose that the foam layer 14 is shape formable. However, the laminate structure provides acceptable noise attenuation for partitions between separate living areas and corridors or public space of average noise. Therefore, it is not seen the laminate structure could not have been shape formable to give the best fit between the wall structures for sound absorption characteristics. Accordingly, the art rejections over Holtrop are sustained.

14. The art rejections over Sato have been maintained for the following reasons. Applicants argue that Sato fails to suggest a foamable resin adhered to a shape-

formable hard plate. Applicants argue that the panel surface 1 as shown in figure is an already shaped panel surface. The arguments are not found persuasive for patentability because they are irrelevant to the structure of the laminate sound insulation board. The fact that the panel is already shaped prior to or after the lamination does not does not differentiate the claimed resin laminate sound insulation board from a prior art laminate structure satisfying the claimed structural limitations. Further, as shown in figure 8, Sato discloses a laminate structure comprising a hard plate 24, a foam layer 23 and a retainer layer 12. The hard plate can be formed of a metal which would be inherently shape-formable (column 16, lines 31-32). Accordingly, the art rejections over Sato are sustained.

15. The art rejections over Murakami have been maintained for the following reasons. Applicants argue that Murakami fails to teach or suggest a foamable resin adhered to a hard plate. The examiner disagrees. Murakami discloses a sound absorbing structure comprising two or more stacked layers of porous members (column 14, lines 48-52). The porous members correspond to Applicants' foamable resin layer and hard plate. Accordingly, the art rejections over Murakami are maintained.

16. The art rejections over Wycech have been maintained for the following reasons. Applicants argue that the metal substrate 1 of Wycech is an already formed panel. Therefore, Applicants assert that Wycech fails to teach or suggest a foamable resin adhered to a hard plate. The examiner disagrees. As previously discussed in the paragraph no. 15 above. The arguments are not found persuasive for patentability because they are irrelevant to the structure of the laminate sound insulation board.

The fact that the panel is already shaped prior to or after the lamination does not differentiate the claimed resin laminate sound insulation board from a prior art laminate structure satisfying the claimed structural limitations. Further, as shown in figures 5-7 and 9, Sato discloses a laminate structure comprising a metal plate 1, a compliant foam layer 5 and a rigid foam layer 6. Accordingly, the art rejections over Wycech are sustained.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485.

The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Hai Vo

HAI VO
PRIMARY EXAMINER